

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Chahee Peter CHO., et al.)	Confirmation No: 1019
)	
Application No.: 10/779,600)	Group Art Unit: 2834
)	
Filed: February 18, 2004)	Examiner: Pedro J. Cuevas

For: PORTABLE RANGE EXTENDER WITH AUTONOMOUS CONTROL OF
STARTING AND STOPPING OPERATIONS

United States Patent and Trademark Office
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Alexandria, Virginia 22314

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants request review of the final rejection mailed March 20, 2006 and the Advisory Action mailed August 7, 2006. No amendments are being filed with this request. This request is filed concurrently with a Notice of Appeal. The review is requested for the reasons provided below.

Claims 1-16 are pending in this application. Claims 1-16 stand rejected under 35 U.S.C. 103(a) over Kawaguchi (U.S. Patent No. 4,961,403) in view of Moore (U.S. Patent No. 6,306,056 B1). Claims 1 and 11 are independent claims.

I. The Final Rejection Fails To Establish A *Prima Facie* Case Of Obviousness

MPEP §706.02(j) states:

To establish a *prima facie* case of obviousness, three basic criteria must be met ... the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Claim 1 recites a method involving at least five steps. The steps generally involve a machine operating as a motor that drives a shaft that turns an engine, sensing the speed of the

shaft and temperature of the engine, supplying fuel to the engine and activating ignition to make the engine a prime mover, and activating the machine so that it operates as a generator. Claim 11 recites a portable range extender involving a sequence. The sequence generally involves a first phase in which a machine operates as a motor that drives a shaft that turns an engine, a second phase in which the engine is activated for operation as a prime mover, and a third phase in which the machine operates as a generator.

The final rejection fails to establish a *prima facie* case of obviousness because the applied references do not teach or suggest all of the claim limitations. As explained in the 7/20/06 Amendment at page 6, Kawaguchi and Moore fail to show or describe a method involving a motor rotating an engine without any fuel or ignition supplied to the engine, achieving a predetermined temperature of the engine, supplying fuel and ignition to the engine, and then activating the motor to function as a generator. Furthermore, Kawaguchi and Moore each fail to show or describe how the engines described therein are rotationally started, or describe any arrangement in which a motor drives an engine in rotation. The final rejection fails to properly assert where the applied references teach or suggest these features of claims 1 and 11.

In apparent response to only one of the arguments presented in the 7/20/06 Amendment (and in part summarized in the prior paragraph), the 8/7/06 Advisory Action asserts that Moore at col. 3, line 50, to col. 4, line 21, explains that "the operation of the systems motor/generators when turned off while the system as a whole is still operating, which inherently requires a driving force to be applied to the engine to start, or re-start it's operation." While that assertion is not clearly understood by Applicants, it appears that the assertion is that the Moore system would inherently include a force to start or re-start Moore's engine.

MPEP §2112(IV) states that:

To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

The Advisory Action asserts only that a "driving force" is inherent in the Moore system. The pending claims do not use the term "driving force." Accordingly, the Advisory Action's assertion regarding inherency does not establish a *prima facie* case of obviousness because it does not establish that Moore teaches or suggests (inherently or otherwise) the features actually recited in the claims.

Furthermore, even if "driving force" was assumed to refer to a machine that can operate as a motor, it is not inherent that such a machine would be capable of operating as a generator. Applicants believe that in known starter motors used to start automobile engines, the starter motor does not typically operate as a generator. Moreover, the existence of known starter motors would preclude the Advisory Action's assertion of inherency because the Moore system could possibly include a known starter motor that is incapable of operating as a generator.

Also, the inherency mentioned in the Advisory Action was not asserted in the non-final office action or in the final rejection, and the final rejection was not necessitated by an IDS or by Applicants' 7/20/06 Amendment. MPEP §706.07(a) states that "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period" (emphasis added). The inherency asserted for the first time in Advisory Action is thus a new ground of rejection, and is it improper and unfair for a new ground of rejection to be asserted at this time. Accordingly, the finality of the rejection should be withdrawn and, if the new ground of rejection is still deemed appropriate, it should be presented in a new non-final office action.

II. Conclusion

For at least the foregoing reasons, the final rejection fails to establish a *prima facie* case of obviousness, and the finality of the rejection is improper because of the assertion of a new grounds of rejection. It is respectfully requested that the rejection, and the finality of the rejection, be withdrawn.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the undersigned to expedite prosecution of the application.

The Commissioner is hereby authorized by this paper to charge any fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-3840. **This paragraph is intended to be a CONSTRUCTIVE PETITION FOR EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).**

Respectfully submitted,



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